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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Re application of: Mansky et al.

Application No.: 09/210,485

Art Unit: 2857

Filed: December 11, 1998

Examiner: Wachsman

For: APPARATUS FOR RAPID SENSOR ARRAY-BASED MATERIALS CHARACTERIZATION

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

REPLY TO PROTEST

Applicants hereby reply to the Protest that is the subject of the Office Action of May 29, 2001.

The Protest cites two items:

- 1) Lai et al, "High Speed (10^4 °C/s) Scanning Microcalorimetry with Monolayer Sensitivity (J/m^2), Appl. Phys. Lett., Vol. 67, No. 9, 28 August 1995 ("Lai et al"); and
- 2) Denlinger et al., "Thin Film Microcalorimeter for Heat Capacity Measurements from 1.5K to 800K", Review Sci. Instrum. 65 (4) April 1994 ("Denlinger et al").

The items cited in the Protest have been cited by Applicants. The Denlinger et al paper was cited by the Applicants already in an Information Disclosure Statement dated February 3, 1999 (see Sheet 4 of Form 1449 – copy attached). The Lai et al paper was also cited in the same Information Disclosure Statement (see Sheet 10 of Form 1449 – copy attached). The Examiner already has considered these items as to related claims (see, e.g., attached Form 1449 from Serial No. 09/210,086). In short,

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(type or print name of person certifying)

the items cited do not materially add anything additional to the body of art already submitted for consideration.

The Protest has failed to apply the references to any specific pending claim of the present application. The Protester (who appears to be anonymous) appears to have based the Protest upon claims that are pending in foreign applications by the Applicants. To assist the Examiner, Applicants attach a copy of published PCT application No. PCT/US99/30008. Applicants can not be certain that the Protest was not directed to a different application or foreign counterpart. However, a review of the PCT claims renders them a more logical candidate than the present pending claims 11, 12, 13 and 46 of the present application. Regardless, the Protest fails to apply an element by element analysis of any claims of the **present application**.

The items cited in the Protest are deficient on their faces to render any of the Applicants' claimed subject matter unpatentable, in view of numerous distinctions, some of which shall be addressed presently. Specifically, though the Denlinger et al paper mentions in passing fabrication of nine devices on a single wafer, there is no indication in the reference that the wafer is ever used in a sensing application where all of the devices still exist on a common wafer, and where the presence of multiple sensors on a single substrate pertains in any way to their intended use or application. To the contrary, the only apparent reason that the nine devices are on the wafer described by Denlinger et al is for manufacturing convenience. Thus, Denlinger et al does not teach or suggest an array of sensors that are to be employed in service on a common substrate as an array. Likewise, Lai et al fail to teach or suggest a plurality of sensors on a common substrate for use as a screening array.

In short, for at least the above reasons, these two items cited by the Protest do not render any of the pending claims unpatentable. To the contrary, the Examiner should take comfort from the fact that the present Protest further provides objective evidence of nonobviousness. That only a small portion of the presently claimed subject matter has been implicated by the Protest, in the face of knowledge of many pending application claims (presumably gained by a review of PCT application No. PCT/US99/30008) suggests that the art (as exemplified by the Protestor) does not possess prior art that would render the claimed subject matter unpatentable.

Conclusions

The present submission renders the Protest moot. Applicants respectfully request that the pending claims be passed to issue notwithstanding the Protest. If for some reason Applicants have not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for the appropriate extension of time required time and/or authorization to charge Deposit Account No. 50-0496 for any fee which may be due.

Date: June 25, 2001

Respectfully Submitted,



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